

REMARKS

Reconsideration of the instant application is respectfully submitted. The present amendment is submitted in conjunction with a Request for Continued Examination (RCE), pursuant to 37 CFR 1.114. The RCE is submitted in response to the Final Office Action of February 3, 2004. There are 45 pending claims in the instant application. Of these, claims 1-6, 10, 16-17, 21-28, 32, 38-39, and 43-45 stand rejected. Claims 18-20 and 40-42 have been objected to by the Examiner as being dependent upon rejected based claims. In the instant application, Applicants have amended claims 1, 3, 15, 16, 22, 23, 25, 37, 38, 44, and 45. The Applicants submit that the present application is in condition for allowance.

Claim Rejections under 35 USC §102(e)

Claims 1-6, 10, 16-17, 21-28, 32, 38-39, and 43-45 have been rejected under 35 USC 102(e) as being allegedly anticipated by U.S. Patent No. 6,453,353 to Win et al (hereinafter Win). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780,

YOR920000502US1
131-0018

227 U.S.P.Q. 773, 777 (Fed. Cir. 1985). The Applicants' traverse the rejections based upon Win because Win does not teach or disclose each of the claimed elements of the invention as provided in Applicants' claims 1-6, 10, 16-17, 21-28, 32, 38-39, and 43-45. Applicants' amended claims 1 and 23 recite, respectively, a method and program storage device for "providing access to data files stored in a data repository comprising the steps of:

- receiving a request for a data file from a requester;
- determining if said requester is authorized to access said requested data file;
- displaying at least one available data format selected from a list of stored data formats, said at least one available data format selectable by said requester;
- translating the requested data file from a stored data format into a requester-selected data format; and
- making said translated data file accessible to said requester if it is determined that said requester is authorized."

Applicants' claims 1 and 23 enable authorized users of disparate systems to access data files that are translated into a data format that is compatible with the system of the requesting user. This enables authorized users to select from at least one available data format based upon factors such as minimizing data loss, processing overhead, as well as the nature of the requested file format and the availability of stored file formats (see Applicants' disclosure page 6). Win does not specifically teach or recite displaying at least one available data format selected from a list of stored data formats, said at least one available data format selectable by said requester. Win further does not teach or suggest translating the requested data file from a stored data format into a requester-selected data format. Rather Win recites a localization service of runtime module 206 whereby a "user can select the time zone, date format and the language in which the user wants to interface with resources. At run time, the Localization Service detects the user's locale settings based on information passed in the HTTP requests from browser 100 to Access Server 106 (col. 11, lines 33-38). Thus, the localization service runtime module of the Win reference

YOR920000S02US1
I31-0018

is used for performing semantic-type conformance of information requests based upon a user's time zone, date preference, and native language but does not recite converting information requests into a requester-selected data format from a list of stored data formats. The only data format conversion recited in the Win reference is the conversion of an existing data format in which the requested information is stored into an HTML document which is a global standard conversion process used in network communications. Thus, the requesting user recited in the Win reference does not select a data format for the requested information as is the case in the instant application.

Accordingly, because Win does not teach or suggest each element of Applicants' claims 1 and 23, Win does not anticipate claims 1 and 23. Applicants' submit that claims 1 and 23 are in condition for allowance for at least these reasons. Claims 2-22 depend from claim 1 and claims 24-44 depend from claim 21. For at least the foregoing reasons, claims 2-22 and 24-44 are in condition for allowance. Notwithstanding, the Applicants have amended claims 3, 15, 16, 22, 25, 37, 38, and 44 to better clarify that which the Applicants regard as the invention. Specifically, claims 3 and 25 have been amended to recite "said requester-selected data format represents a version of the data file that is compatible with a particular software application environment for using the requested data." Claims 15 and 37 have been amended to recite "said translated data file retained at said response repository is further translated into an alternative data format selectable from at least one available data format in said list of stored data formats, said alternative data format selected by an authorized requester."

The Applicants further submit that amended claim 45 is in condition for allowance for at least the reasons provided above with respect to claims 1 and 23.

Claim Rejections under 35 USC §103(a)

The Examiner has rejected claims 7-9, 11-15, 29-31, and 33-37 under 35 USC 103(a) as being unpatentable over Win. The Applicants respectfully disagree. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a

YOR920000502US1
131-0018

12

prima facie case of obviousness. *In re Fine*, U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants' claims 7 and 29 recite "said translated data file is retained at a response repository outside of said firewall for a predetermined time period." The translated data file refers to a data file translated based upon a requester-selected data format provided by the invention. The translated data file in the Win reference does not result from a user-selected data format request but from a network standard (e.g., HTML) (col. 11, line 38). Thus, the translated data files of the instant application are not synonymous with the translated documents in the Win reference. Accordingly, it would not have been obvious to one of ordinary skill in the art to modify Win to include this feature. For at least this reason, claims 7 and 29 are not obvious over Win. Assuming for the sake of argument, that claims 7 and 29 may be construed as obvious over Win, it does not cure the deficiencies stated above, namely, that claims 1 and 23, respectively, are not anticipated by Win. As claim 7 is dependent upon claim 1, and claim 29 is dependent upon claim 23, the Applicants further submit that claims 7 and 29 are in condition for allowance. Reconsideration of the rejections is respectfully requested. Moreover, the Applicants' submit that claims 8, 9, 11-15, 30, 31, and 33-37 are allowable for at least the reasons given above with respect to claims 7 and 29.

Conclusion

No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 50-0510 maintained by Applicants' attorneys.

Respectfully submitted,

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YOR920000502US1
131-0018

14